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JJGJr.:01-02

Paper 15

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In re Application of
Fowler, et al.
Application No. 08/876,132
Filed: 23 June, 1997
Attorney Docket No.: GC372

**OFFICE OF PETITIONS
ON PETITION**

This is a decision on the petition filed on 11 October, 2001, under 37 C.F.R. §1.181¹ seeking the withdrawal of the holding of abandonment, but not sufficiently and appropriately supplemented until 10 January, 2002, to revive an application abandoned due to unintentional delay 37 C.F.R. §1.137(b)².

¹ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. ***

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. ***

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. ***

² The regulations at 37 C.F.R. §1.137 provide in pertinent part:

§ 1.137 Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

(b) *Unintentional*. If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(c) *Reply*. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

[47 Fed. Reg. 41277, Sept. 17, 1982, effective Oct. 1, 1982; para. (b) 48 Fed. Reg. 2713, Jan. 20, 1983, effective Feb. 27, 1983; paras.

(a) - (c), paras. (d) & (e) added, 58 Fed. Reg. 44277, Aug. 20, 1993, effective Sept. 20, 1993; para. (c) revised, 60 Fed. Reg. 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Sept. 8, 2000; revised, 65 Fed. Reg. 57024, Sept. 20, 2000, effective Nov. 29, 2000]

The petition under 37 C.F.R. §1.181 is DISMISSED for reasons as set forth below,³ and the petition under 37 C.F.R. §1.137(b) is GRANTED.

BACKGROUND

A review of the record reveals:

- the instant application was filed on 23 June, 1997;
- the Petitioner failed to respond to a Notice of Missing Parts⁴ mailed on 5 September, 1997 (to the specified correspondence address of record: 180 Kimbal Way, South San Francisco, CA 94080),⁵ with a response due date on or before 5 November, 1997;
- the instant application went abandoned after midnight on 5 November, 1997;
- a Status Inquiry was filed on 2 February, 1998;
- a Power to Inspect and Make Copies was filed on 22 May, 1998;
- after abandonment, Petitioner filed on 27 August, 1998:
 - the oath/declaration signed by all named inventors,
 - an information disclosure statement,
 - a copy of the Notice of Missing Parts,
 - paper and computer-readable copy of the sequence listing (with Statement of Sameness), and
 - a Preliminary Amendment,
 - a Notice of Change of Address (to the Page Mill Road address),
 - a Request for a Corrected Filing Receipt,

³ Pursuant to Petitioner's authorization to charge/credit Deposit Account 01-1047 (GC372):

- the petition fee under 37 C.F.R. §1.137(b) of \$1,280.00 previously has been charged;
- the extension of time fee (\$1,440.00), previously improperly charged, has been credited;
- the late-filing surcharge (\$130.00), never previously charged, now has been charged; and
- the petition fee (\$130.00) under 37 C.F.R. §1.181 for the improper petition is charged.

⁴ The Notice of Missing Parts required the filing of an oath or declaration executed by all named inventors and the payment of the late-filing surcharge.

⁵ While the application also contains another address for then-Counsel Debra Glaister (925 Page Mill Road, Palo Alto, CA 94304-1013), the specified correspondence address as filed is the Kimbal Way address.

- a Petition to Withdraw the Holding of Abandonment, and
- authorization to charge (or credit) Deposit Account 07-1048 (Docket No. GC372) for appropriate fees (refund);
- the 27 August, 1998, petition, was not treated at that time (although inappropriate, it should have been dismissed, but was not);
- the Notice of Abandonment was mailed on 18 November, 1998;
- on 5 April, 1999, Petitioner again advanced the petition to Withdraw the Holding of Abandonment;
- the 5 April, 1999, petition--again inappropriate--was not treated and dismissed;
- on 11 October, 2001, Petitioner once again advanced the petition to Withdraw the Holding of Abandonment;
- during a telephone conference with the Office of Petitions, Petitioner was directed to:
 - the data submitted by Petitioner in the application specifying the Kimbal Way correspondence address as having triggered the abandonment, and
 - the inappropriateness of a Withdrawal of the Holding of Abandonment in the premises;
- on 10 January, 2002, Petitioner filed the Petition to Revive under 37 C.F.R. §1.137(b) and authorization for applicable fees to be charged to Deposit Account 07-1048 (Docket No. GC372).⁶

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁷ And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably⁸ or unintentionally,

⁶ Petitioner also has requested and authorized fees for extensions of time. These are unnecessary.

⁷ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁸ The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay,

respectively, abandoned application under this congressional grant of authority. Further, Petitioner must evidence at least such diligence in addressing a question of abandonment as one must evidence in the prosecution of the application--i.e., such diligence as one would give to one's most important business affairs.⁹

Moreover, the courts have determined the construct for properly supporting an allegation of non-receipt of an Office action in seeking withdrawal of a holding of abandonment.¹⁰

Petitioner's Argument as to
Withdrawal of
the Holding of Abandonment

Petitioner has argued that the Office erred in holding abandoned the instant application.

As is clear from the Record, the Office mailed a Notice of Missing Parts to the specified Kimbal Way correspondence address.

Thus, Petitioner either failed to:

- correct the address before the filing of the application, or
- timely file a Notice of Change of Address upon that event.¹¹

Therefore, while Petitioner's contention may be interesting, it is wholly unpersuasive because it has no basis in law.

To the contrary, as noted earlier the statutory provisions at 35 U.S.C. §133 (1994) mandate abandonment in the absence of proper timely reply to an Office action or

and also, by definition, are not intentional. Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁹ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887). See also: In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). Decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition cannot be granted where a petitioner has failed to meet his or her burden of proof. Haines v. Ouiqq, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

¹⁰ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

¹¹ As noted above, the Notice of Change of Address was not filed until 27 August, 1998--almost a year after the mailing of the Notice of Missing Parts and nine (9) months after the due date therefor.

Notice. And the regulations at 37 C.F.R. §1.134¹² and §1.135¹³ provide similar requirements and effects.

As is clear, Petitioner fails to satisfy the burdens set forth in Delgar v. Schulyer.

Withdrawal of the holding of abandonment is not proper, and no term adjustment will be proper because Petitioner failed to file a grantable petition from abandonment in November 1997 until January 2002.

Alternative Venue

Petitioner has satisfied the requirements for revival under 37 C.F.R. under 37 C.F.R. §1.137(b).¹⁴

Therefore, for the reasons stated above the petition under 37 C.F.R. §1.181 is dismissed, and the petition under 37 C.F.R. §1.137(b) is granted.

The record (including the petitions filed on 27 August, 1998, 5 April, 1999, 11 October, 2001, and 10 January, 2002) does not necessitate a finding that the delay between midnight 5 September, 1997, and 10 January, 2002, was not unintentional.

Rather, the Patent and Trademark Office is relying in this matter on Petitioner's duty of candor and good faith when accepting Petitioner's representation that the delay in filing the response was unintentional.¹⁵

This application is being forwarded to OIPE for the issuance of a corrected filing receipt specifying Genencor International, Inc., as the correct addressee for mailings before the application is assigned to a Technology Center for processing in due course.

¹² The regulations at 37 C.F.R. §1.134 provide:

§ 1.134 Time period for reply to an Office action.

An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.
[47 Fed. Reg. 41276, Sept. 17, 1982, effective Oct. 1, 1982; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

¹³ The regulations at 37 C.F.R. §1.135 provide:

§ 1.135 Abandonment for failure to reply within time period.

(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.

(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.

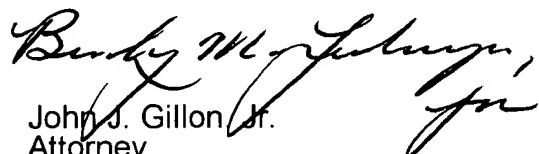
(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.

[Paras. (a), (b), and (c), 47 Fed. Reg. 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 Fed. Reg. 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

¹⁴ See: Fn. 2.

¹⁵ See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137(b) to the Patent and Trademark Office).

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